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08/988,292	12/10/1997	FELIX THEEUWES	ARC-2600-R1	7298

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EXAMINER

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ART UNIT	PAPER NUMBER
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3763

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**MAILED**  
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**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 25

Application Number: 08/988,292  
Filing Date: December 10, 1997  
Appellant(s): THEEUWES ET AL.

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Owen Bates

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 18, 2002.

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**(2) *Related Appeals and Interferences***

A statement identifying the real party in interest is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-5, 8, 10-12, 14, 15, 18-21, 28, and 29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

2,922,425	LERNER ET AL.	1/1960
5,261,426	KELLET ET AL.	11/1993
3,964,482	GERSTEL ET AL.	6/1976

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**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

- Claims 1-5, 10, 11, 14, 15, 18-20, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerner et al (US2,922,425).

Lerner discloses an applicator or dispensing device, figure 4, having a member 12, a plurality of protrusions 14 extending from the first surface, and a connecting medium 16.

- Claims 1, 8, 10, 11, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kellet et al (US 5,261,426).

Kellet discloses an applicator having a member 6, a plurality of protrusions 5 extending from the first surface, and opening therethrough (see figure 2), and a connecting medium 1. The opening can be seen as a lower indentation (shown in fig. 2) where the pad 1 is going to be located.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner et al in view of Gerstel et al (US 3,964,482).

Lerner discloses an applicator or dispensing device having the elements substantially as claimed. However, Lerner fails to disclose the protrusion comprising blades.

Gerstel teaches a drug delivery device having puncturing protrusions (col. 7 lines 32-37) for piercing the skin. The protrusions can be a pyramidal point configuration. The definition of "blade", according to Webster's II New Riverside University dictionary (1984), is a "*flat-edged cutting part of a sharpened tool or weapon*". The pyramidal point configuration includes side-cutting faces that are flat-edged cutting parts that may be considered as blades. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Gerstel's protrusion configuration into Lerner's protrusions. Doing so would have improved the protrusion with the addition of cutting edges, and their piercing effect.

**(11) Response to Argument**

In response to Appellant's arguments to the definition of "body surface", and "agent", during the prosecution of the pending claims, the broadest reasonable interpretation consistent with the specification must be given. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), and *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) in MPEP 2111. In view of a broad interpretation of the claims, the "body surface" could be interpreted as any kind of surface that can be pierced (including a plastic film), and an "agent" could be interpreted as any kind of agent that can be delivered with the device. However, Appellants define "body surface" as *used herein refers generally to the skin, mucous membranes, and nails of an animal or human,*

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*and to the outer surface of a plant, (p. 7, lines 21-23), and "agent" as the terms "substance", "agent" and "drug" are used interchangeably herein and broadly include physiologically or pharmacologically active substances for producing a localized or systemic effect or effects in mammals including humans and primates, avians, valuable domestic household, sport or farm animals, or for administering to laboratory animals such as mice, rats, guinea pigs, and the like, (p. 5, lines 8-13).* Lerner's device is capable of piercing the outer surface of a plant or a mucous membrane and deliver any other agent not disclosed by Appellants or Lerner. Furthermore, the claims are broad enough and not limited to the human body, and they do not particularly specify which "body surface" is going to be pierced in light of the specification.

"An Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909.F.2d 1464, 1469, 15 USPQ 1525, 1528 (Fed. Cir. 1990).

In response to appellant's argument that the protrusions are "capable of piercing said body surface", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Examiner refers Appellants to the remarks set forth above in regards to the "body surface". Also, Lerner discloses a pointed protrusion that clearly can pierce a body surface.

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With respect to Appellants arguments in section 2a. Capable of performing same function (pages 6-7 of Brief), the examiner use Lerner's figures 1-9, and not to figures 10-17 of the rejection. Also, figures 7 and 8 shows that the sponge mass 32 is compressed against the hair (body surface), and delivers the agent effectively. Lerner's intended use (hair color) is different from Appellants (skin, outer surface of a plant, or a mucous membrane), and does not preclude that Lerner's device can perform the function as claimed.

With respect to Appellants arguments to Kellett, please see the Examiner's arguments above which respect to Lerner. The same remarks apply to Kellet.


With respect to Appellant's arguments to Lerner in view of Gerstel, see the rejection set forth above.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


September 6, 2002


  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

Conferees

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